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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ECKERT SEAMANS CHERIN & MELLOTT
600 GRANT STREET
44TH FLOOR
PITTSBURGH, PA 15219

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,384

Applicant(s)

DUPPSTADT, ARTHUR G.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,4-14 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6 is/are allowed.
- 6) ☐ Claim(s) 1,4,9-14 and 16 is/are rejected.
- 7) ☐ Claim(s) 5,7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 5 and 7 (and dependent claim 8) are objected to for the following reasons. Since the intended meaning could be determined from what is set forth in the specification and drawings, 112 rejections were not made but instead these lack of clarity issues have been raised in the following objections.

In reference to claim 5, lines 5-11 are repeating limitations that are already set forth either in dependent claim 4 or independent claim 1 or within the claim and the repetition of these limitations creates a lack of clarity. It is suggested that applicant delete lines 5-11.

In reference to claim 7, in line 5 it is stated "a spherical portion disposed radially adjacent to said central portion..." which creates a lack of clarity since "said central portion" has not yet been claimed as a limitation. It is suggested that applicant change this part of the claim to state, "a spherical portion disposed radially adjacent to said aspheric portion..." (similar to what is claimed in independent claims 1 and 6).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Seidner et al.

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Seidner et al reads on these claims by disclosing the limitations therein including the following: a multifocal contact lens (abstract); comprising an inner concave and an outer convex surface (Figure 2 and 6); an aspheric portion structured to provide distant vision (Figure 2, "18", column 8, line 52, Figure 6, "combined "126" and "128", column 10, lines 30-35 since applicant has defined "distant vision" to be in terms of "far distances to intermediate distances" re applicant's specification page 6); a spherical portion disposed radially adjacent to the central portion (Figure 2, "12", column 8, line 59, Figure 6, "130", column 10, line 35 re having a "spheric power curve"); and the portions disposed radially adjacent to each other (Figure 6 with portions "126-128" radially adjacent to portion "130"). Furthermore, in reference to the "radially adjacent" and the Figures 1-2 embodiment, in column 13, line 8, "24" of Figure 1 is described as a transition junction where surface 12 meets surface 18 and therefore these two surfaces are "radially adjacent" to each other. Seidner et al further discloses this spherical portion providing reading vision (column 8, line 59, column 10, line 35); the aspherical portion in the center of the lens and the spherical portion of annular shape and surrounding the aspherical portion (Figures 1-2 and 6). Seidner et al further discloses the spherical and aspherical portions on the outer surface of the lens (Figure 2) and the lens having only one central spherical portion and annular aspheric portion (Figure 2 and 6 with the Figure 6 embodiment disclosing just one aspheric portion if "126" and "128" combined is considered as "the portion"). The lens of Seidner et al will inherently be transparent, this being reasonably based upon it being well known that corrective contact lenses are transparent in order to provide optimal viewing correction. The lens of Seidner et al will

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inherently provide simultaneous distant and reading vision, this being reasonably based upon it being well known that bifocal contact lenses formed of concentric annular zones, similar to Seidner et al, provide the optical correction through the use of "simultaneous vision" correction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10-11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidner et al in view of Portney.

In reference to these claims, Seidner et al discloses as is set forth above but discloses the corrective portions on the outer surface and not on the inner surface as claimed. Portney teaches that in a multifocal contact lens comprising annularly concentric near and distant correction portions (abstract, Figure 3A, column 8, lines 40-61), similar to Seidner et al, that the corrective portions can be formed on either the inner or outer surface of the lens to provide the desired optical correction (column 8, line 60, column 5, lines 54-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the corrective portions of Seidner et al formed on the inner surface of the lens since Portney teaches that in a multifocal contact lens comprising annularly concentric near and distant correction portions, that the corrective portions can be formed on either the inner or

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outer surface of the lens to provide the desired optical correction. In reference to claim 5, since the claimed "outward portion" has substantially the same radius as the spherical portion, then the innermost portion of the spherical portion "12" of Figure 2 or of spherical portion "130" of Figure 6 can be considered this "outward portion" of the aspherical portion. It is believed that the contact lens of Seidner et al will inherently have the minimum thickness as claimed in claim 8, this being reasonably based upon what is disclosed in Seidner et al.

In reference to claim 16, Seidner et al discloses the lens as a contact lens but not as a surgically implantable lens. Portney teaches that a multifocal lens comprising annularly concentric near and distant correction portions (abstract, Figure 3A, column 8, lines 40-61), similar to Seidner et al can be adapted to be in the form of either a contact lens or an intraocular lens i.e. a "surgically implantable lens" depending upon the intended user of the lens (abstract, column 5, lines 20-60 and column 8, lines 40-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Seidner et al adapted for use as a surgically implantable lens since Portney teaches that a multifocal lens comprising annularly concentric near and distant correction portions can be adapted to be in the form of either a contact lens or an intraocular lens i.e. a "surgically implantable lens" depending upon the intended user of the lens.

Prior Art Citations

Roffman et al is being cited herein to show a contact lens that would make obvious a number of the above rejected claims, however, such rejections would have been repetitive. See specifically Figure 1 and column 4, line 1.

Allowable Subject Matter

Claims 6-7 are allowed (with claim 7 overcoming the objection above).

Claims 5 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (with claim 5 also overcoming the objection above).

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with respect to claims 5 and 8, none of the prior art either alone or in combination disclose or teach of the claimed multifocal contact lens comprising an aspheric portion structured to provide distant vision, a spherical portion structured to provide reading vision, the spherical portion disposed radially adjacent the aspherical portion, the aspheric portion disposed within the center of the lens with the spherical portion of annular shape and surrounding the aspheric portion, the aspheric portion and spherical portion formed within the inner concave surface, and specifically further with an annular radially outward portion of the aspheric portion abutting the annular spherical portion and having substantially the

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same radius as the spherical portion. Specifically, with respect to claims 6-7, none of the prior art either alone or in combination disclose or teach of the claimed multifocal contact lens comprising an aspheric portion structured to provide distant vision, a spherical portion structured to provide reading vision, the spherical portion disposed radially adjacent the aspherical portion, the aspheric portion disposed within the center of the lens with the spherical portion of annular shape and surrounding the aspheric portion, the aspheric portion and spherical portion formed within the inner concave surface, and specifically further with the aspherical central portion having a diameter as claimed or the annular spherical portion having a width as claimed.

Response to Arguments

Applicant's arguments received December 16, 2000 have been considered but with respect to the Seidner et al reference and the rejections set forth above, they are not persuasive. Specifically, applicant argues that the Seidner et al lens is a diagnostic lens, however, the lens is still a contact lens that is providing both near and distant vision correction and therefore is still a multifocal contact lens that reads on the limitations as set forth above. Furthermore, the Figure 6 embodiment also reads on the claims as stated above. Specifically, applicant has defined "distant vision" as correcting "far distances to intermediate distances" (specification page 6). Therefore, the combined zones "126-128" of Seidner can be considered as an "aspheric portion" structured to provide "distant vision" since "126" corrects intermediate vision (column 10, line 30) and "128" corrects distant vision (column 10, line 33). The Figure 6 embodiment also describes near vision portion "130" in terms of having a "spheric power curve" (column

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10, line 35) and therefore discloses the near vision portion as a "spherical portion". For applicant's information, upon further consideration and in light of applicant's arguments the examiner has reconsidered the rejection of claims 5 and 8 and has indicated these claims as allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'J. Schwartz', with a stylized flourish at the end.

Jordan M. Schwartz
Primary Examiner
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March 12, 2003